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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,652	03/22/2000	Wen-Chen Su	AVERYRC.5CPCP1	9479

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CASELLA & HESPOS LLP
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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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05/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/918,652	Applicant(s) SU ET AL.	
	Examiner Patricia L. Nordmeyer	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-14, 21 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-14, 21, and 23-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 19, 2007 has been entered.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 12, 21, 23, 24, 27 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Knauf (USPN 5,691,022).

Knauf discloses a pressure-sensitive adhesive label (Column 3, lines 3 – 4; Column 4, lines 43 – 44) construction incorporating a multilayer release liner (Column 3, lines 21 – 25; Figure 1, #5) comprising a backing made of paper (Column 3, lines 39 – 41), a support layer on the backing (Column 3, lines 26 – 38; Figure 2, #2), a release layer on the support layer (Column 4, lines 11 – 13; Figure 2, #8) and wherein the release layer comprises silicone (Column 4, lines 11 – 13) and is deposited on the support layer substantially when the support layer is deposited

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on the backing so that the release layer is dispersed into the support layer to define an irregular interfacial area with small domains of the silicone in the support layer (Column 4, lines 56 – 68), the release layer further defining a release surface (Column 4, lines 11 – 13), at least 40% of the silicone being within 1 μm of the release surface or 70% within 2 μm of the release surface (Figure 2, #8), whereby the irregular surface interface between the release layer and the support layer decreases a propensity of the release layer to separate from the support layer (Column 2, lines 32 – 36) as in claims 12, 21, 23, 24 and 30. With regard to claim 27, the backing has small pores and openings and the support layer substantially fills the small pores and openings of the backing (Column 3, lines 32 – 45).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 13, 14, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knauf in view of Kumar et al. (USPN 5,229,179).

Knauf discloses a pressure-sensitive adhesive label (Column 3, lines 3 – 4; Column 4, lines 43 – 44) construction incorporating a multilayer release liner (Column 3, lines 21 – 25; Figure 1, #5) comprising a backing made of paper (Column 3, lines 39 – 41), a support layer on the backing (Column 3, lines 26 – 38; Figure 2, #2), a release layer on the support layer (Column

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4, lines 11 – 13; Figure 2, #8) and wherein the release layer comprises silicone (Column 4, lines 11 – 13) and is deposited on the support layer substantially when the support layer is deposited on the backing so that the release layer is dispersed into the support layer to define an irregular interfacial area with small domains of the silicone in the support layer (Column 4, lines 56 – 68), the release layer further defining a release surface (Column 4, lines 11 – 13), at least 40% of the silicone being within 1 μm of the release surface or 70% within 2 μm of the release surface (Figure 2, #8), whereby the irregular surface interface between the release layer and the support layer decreases a propensity of the release layer to separate from the support layer (Column 2, lines 32 – 36). However, Knauf fails to disclose the release surface exhibits a 90° peel release force at a rate of 7.6 m/min of less than about 40 cN/25mm or 20 cN/25mm.

Kumar et al. teach a release coating that has a release surface exhibits a 180° peel release force at a rate of 7.6 m/min of less than about 40 cN/25mm or 20 cN/25mm (Table 3, Example 7) made with silicone (Column 31, lines 36 – 39) for the purpose of having a controlled and predictable release (Abstract).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made that the release coating would have the peel release force of 20 cN/25mm or less in Knauf in order to have controlled and predictable release as taught by Kumar et al.

5. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knauf in view of Freedman (USPN 4,713,273).

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Knauf discloses a multi-layer release liner as detailed above except for the support layer including a filler material selected for substantially sealing the small pores in the backing while being a material capable of being expressed from a dual-die and wherein the filler material of the support layer comprises latex.

Freedman teaches a multi-layer release liner (Column 11, line 56) where support layer including a filler material selected for substantially sealing the small pores in the backing while being a material capable of being expressed from a dual-die (Column 11, lines 61 – 62) and wherein the filler material of the support layer comprises latex (Column 3, lines 15 – 19) for the purpose of forming a face stock that has from the filler material which helps resist curling in the material.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the filler material made from latex in the support material in Reed in order to form a face stock that has from the filler material which helps resist curling in the material as taught by Freedman.

Response to Arguments

6. Applicant's arguments filed September 17, 2007 have been fully considered but they are not persuasive.

In response to Applicant's argument that Knauf does not disclose or suggest "a release layer that is deposited on the support layer substantially when the support layer is deposited on the backing so that the release layer is dispersed into the support layer to define an irregular interfacial area with small domains of silicone in the support layer" due to the multiple step method used by Knauf, the claims define the product by how the product was made. Thus, claim 1 is a product-by-process claim. For purposes of examination, product-by-process claims are not limited to the manipulation of the recited steps, only the structure implied by the steps. See MPEP 2113. In the present case, the recited steps imply a structure with release layer comprising silicone dispersed into the support layer since the support layer may be coated on rough surface of the paper layer (Column 3, lines 51 – 53): therefore, the reference suggests such a product with silicone dispersed into support layer. Also, the claim language states that "a release layer that is deposited on the support layer substantially when the support layer is deposited on the backing". The term "substantially" is an indefinite term that opens claim language to allow a delay between the coatings of the layers, which could include the additional step of drying.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571)272-1496. The examiner can normally be reached on Mon.-Thurs. from 10:00-7:30 & alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena L. Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer
Primary Examiner
Art Unit 1794

/Patricia L. Nordmeyer/
Primary Examiner, Art Unit 1794